1. (twice amended) In a microscope having a non-scanning illumination device for illuminating a subject over a field of view by directing light along an illumination beam path through a main objective of said microscope or in a region of a main objective of said microscope, and a plurality of optical components in said illumination beam path, the improvement comprising:

a mechanism for moving at least one of said plurality of optical components so that a reduction of light intensity incident upon the subject over the field of view occurs because of the movement of said at least one optical component.

11. (twice amended) A method for darkening an illuminated subject under a microscope having a non-scanning illumination device with an integrated illumination beam path in which a plurality of optical components are arranged, said method comprising the step of:

moving at least one of said plurality of optical components so that a reduction of light intensity incident upon the subject over the field of view occurs because the movement of said at least one optical component causes light to arrive at the subject in a more diffuse or defocused fashion.

REMARKS

Claim Rejections 35 U.S.C. § 102

Claims 1, 3 and 9 are rejected under 35 USC 102(b) as being anticipated by US 5,155,509 (Kleinberg). The rejection is respectfully overcome by the amendment to Claim 1 presented above for the following reasons.

Independent Claim 1, prior to the present amendment, required "a mechanism for moving at least one of said plurality of optical components so that *a darkening occurs at the subject* because of the movement of said at least one optical component." In paragraph 9(B) of the Final Office Action, the Examiner has provided a thorough and clear explanation of how Kleinberg meets the quoted claim limitation. Kleinberg, as it is now understood from the Examiner's

discussion, involves a darkening at one area or point of the subject (patient's eye) accompanied by a corresponding brightening of a different area of the subject. The present invention, by contrast, involves a reduction in the overall light intensity reaching the subject in the field of view to protect the patient's eye from damage. Accordingly, Claim 1 as now amended reads "a mechanism for moving at least one of said plurality of optical components so that *a reduction of light intensity incident upon the subject over the field of view occurs* because of the movement of said at least one optical component." In Kleinberg, light intensity is shifted from one area of the patient's eye to another area of the patient's eye in the field of view; in amended Claim 1, overall light intensity reaching the eye in the field of view is reduced.

Therefore, the amendment to Claim 1 is respectfully thought to make the Claim 1, and dependent Claims 3 and 9, novel over Kleinberg. The amendment was not made earlier because the Examiner's interpretation of the Kleinberg reference as it pertains Claim 1 was not fully appreciated, and the previous wording in Claim 1 was respectfully thought to distinguish over Kleinberg at the time the wording was adopted. The Examiner's discussion in the Final Office Action has allowed for the drafting of claim language that properly distinguishes over Kleinberg. Consequently, entry of the present amendment to Claim 1 is respectfully requested at the discretion of the Examiner, and allowance of Claims 1, 3, and 9 is sought.

Claims 1, 3 and 10 are rejected under 35 USC 102(b) as being anticipated by US 4,209,225 (Kumiomi et al.). The rejection is respectfully traversed for the following reason.

In the Final Office Action, near the top of page 3, it is asserted that movement of tube (4) will cause a defocusing at the patient's eye. However, applicant respectfully disagrees with this interpretation. Column 3, lines 20-26 of Kumiomi et al. reads as follows:

> Although such axial movement of the body tube 4 results in a variation of the distance between the collimating lens 3 and the imaging lens 5, **this variation has no effect on the optical system due to parallelism of the beam B in this region. That is, no change occurs in illuminating, observing, imaging and photographing conditions**.

Reconsideration and withdrawal of the rejection of Claim 1, and Claims 3 and 10 depending therefrom, is respectfully requested.

Claim Rejections 35 U.S.C. § 103

Claims 11 and 14 are rejected under 35 USC 103(a) as being unpatentable over Kleinberg. The rejection is respectfully overcome by the amendment to Claim 11 presented above for the reasons given above with respect to apparatus Claim 1. The amendment to Claim 11 was not made earlier for the same reasons given regarding the amendment to Claim 1. Entry of the amendment and removal of the rejection of Claims 11 and 14 is now sought.

Claims 11 and 15 are rejected under 35 USC 103(a) as being unpatentable over Kumiomi et al. The rejection is respectfully traversed because movement of the body tube (4) of Kumiomi et al. does not cause a defocusing at the subject to reduce incident light intensity over the field of view. Please see Kumiomi et al. at column 3, lines 20-26. Favorable reconsideration of Claims 11 and 15 is respectfully requested.

Examiner's Response to Arguments

The Examiner is thanked for reconsideration and withdrawal of the rejections based on Engelhardt et al., Biber et al., and Nakazaki et al., and for the explanation regarding application of the Kleinberg reference.

Allowable Subject Matter

The indication of allowable subject matter in Claims 4-8 and 12-13 is acknowledged with thanks. it is respectfully urged that the objection to these claims is overcome by placing Claims 1 and 11 in a condition for allowance pursuant to this amendment and response.

Conclusion

If the Examiner has any questions, or if any information is needed to assist in expediting prosecution of the instant application, the undersigned attorney of record may be contacted at the number provided below.

Respectfully submitted,

HODGSON RUSS LLP

By _____
George L. Snyder, Jr.
Reg. No. 37,729

One M&T Plaza, Suite 2000
Buffalo, New York 14203-2391
(716) 856-4000
DATED: December 20, 2002

3997.0036

I hereby Certify that this Correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on December 20, 2002.

Barbara Haggerty
Name
Barbara Haggerty
Signature
December 20, 2002
Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ulrich Sander

Serial No.: 09/847632 Group: 2872

Filed: May 2, 2001 Examiner: Thong Q. Nguyen

For: MICROSCOPE

MARKED VERSION OF AMENDED CLAIMS

Box AF
Commissioner for Patents
Washington, D.C. 20231

Sir:

This Marked Version of Amended Claims accompanies an Amendment and Response in reply to the Final Office Action mailed October 21, 2002.

Please amend Claims 1 and 11 as follows:

1. (twice amended) In a microscope having a non-scanning illumination device for illuminating a subject over a field of view by directing light along an illumination beam path through a main objective of said microscope or in a region of a main objective of said microscope, and a plurality of optical components in said illumination beam path, the improvement comprising:

a mechanism for moving at least one of said plurality of optical components so that [a darkening occurs at the subject] a reduction of light intensity incident upon the subject over the field of view occurs because of the movement of said at least one optical component.

11. (twice amended) A method for darkening an illuminated subject under a microscope having a non-scanning illumination device with an integrated illumination beam path in which a plurality of optical components are arranged, said method comprising the step of:

moving at least one of said plurality of optical components so that [a darkening occurs at the subject] a reduction of light intensity incident upon the subject over the field of view occurs because the movement of said at least one optical component causes light to arrive at the subject in a more diffuse or defocused fashion.

Respectfully submitted,

HODGSON RUSS LLP

By _____
George L. Snyder, Jr.
Reg. No. 37,729

One M&T Plaza, Suite 2000
Buffalo, New York 14203-2391
(716) 856-4000
DATED: December 20, 2002